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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,932	01/25/2002	Anthony G. Martin	50642.00025	8366
30256	7590	09/16/2004	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P			HARTMAN JR, RONALD D	
600 HANSEN WAY			ART UNIT	
PALO ALTO, CA 94304-1043			PAPER NUMBER	
			2121	
DATE MAILED: 09/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/056,932	<b>Applicant(s)</b> MARTIN ET AL. 	
	<b>Examiner</b> Ronald D Hartman Jr.	<b>Art Unit</b> 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-33 are presented for examination.

#### ***Response to Amendment***

2. The applicant's amendment to claims 1, 9, 17 and 25-29 has necessitated the new grounds of rejection as set forth below in this office action. Accordingly, this action is made **FINAL**.

#### ***Claim Objections***

3. Claim 33, line 1, "production" should be changed to "product".  
Claim 33 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. All of the features and or limitations described by way of pending claim 33 are already presented by way of pending claim 28, that is, the use of table to determine content availability.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-25, 27 and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Uchiyama, U.S. Patent Application Publication No. 2002/0065802.

As per claims 1, 9, 17, 25, 27 and 29, Uchiyama teaches a method comprising:

- obtaining a set of one or more rules for collecting information by a first application residing on a client (i.e. the user entering data into the terminal directly, [0058];
- utilizing the first application to monitor a second application on the client in communication with the a network for information that satisfies one or more rules of the set of rules (i.e. monitoring the browser software, [0058]), wherein the second application is utilized by a user to access sites coupled to the network (i.e. inherent to the capabilities and or functions of a conventional web browser);
- collecting information that satisfies one or more rules of the set of rules from the second application utilizing the first application (i.e. using the program code, Figure 1 element 140, to collect advertisements for the user, [0055]-[0056] and collecting data, [0059]);
- storing at least a portion of the collected information on the client utilizing the first application ([0059]); and
- receiving content via the network for presentment by the first application based on the portion of the collected information stored on the client (i.e. transmitting the collected information to a remote server for further processing, to provide content to the user, [0059] and Figure 7).

As per claims 9, 17, 25, 27 and 29, since Uchiyama clearly teaches the method for collecting information based on the behaviors of a user, computer logic for, a computer program product for and a system for performing the features of the aforementioned method, as claimed by way of claim 1, are inherent to Uchiyama since

the system utilizes a computer network and computer software in order to be implemented.

As per claims 2, 10, 18, 27 and 29, Uchiyama further teaches that the collected information includes behavioral information about the user (i.e. [0060], [0068] and [0098]).

As per claims 3, 11, 19, 27 and 29, Uchiyama further teaches that the set of one or more rules being updated based on the collected information is a function that the disclosed system of Uchiyama provides the capability of performing since the intent of Uchiyama is to provide for a flexible, yet fluidly adaptive, user behavioral driven interaction mechanism for use with browsing the Internet.)

As per claims 4, 12 and 20, Uchiyama further teaches that at least one of the rules includes a trigger, wherein the collected information trips the trigger, and wherein a notification is transmitted to a location via the network (i.e. sending information to the central server, Figure 1 element 120, [0059]).

As per claims 5, 13 and 21, Uchiyama further teaches that the set of one or more rules is obtained utilizing the network (i.e. the behaviors of the users being determined based on the activity of the browser, [0058]).

As per claims 6, 14, 22, 27 and 29, Uchiyama further teaches that the content includes one or more additional rules for controlling the presentment of the content (i.e. customized or personalized advertising based on user preferences, [0055]).

As per claims 7, 15, 23, 27 and 29, Uchiyama further teaches that at least a portion of the collected information is transmitted to a location utilizing the network (i.e. sending information to the central server, Figure 1 element 120, [0059]).

As per claims 8, 16, 24, 27 and 29, Uchiyama further teaches that the information transmitted to the location includes an identifier, and wherein at least a portion of the received content is based on the identifier (i.e. a URL, [0058]).

As per claim 30, Uchiyama teaches that the second application is a web browser (i.e. Figure 6).

As per claim 31, Uchiyama teaches the collected information including information relating to a time at which the second application is utilized to access at least one site coupled to the network (i.e. time spent on a particular website, [0014]).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama, U.S. Patent Application Publication No. 2002/0065802, in view of Moshfeghi et al., U.S. Patent No. 6,076,166.

As per claims 26, the rejection of claim 1, from above, is applied equally herein.

As per claims 26 and 32, Uchiyama does not specifically teach the use of priorities for content presentation.

Moshfeghi et al., teaches the use of priorities for personalizing content presentations based on the desires of users using a hospital intranet (i.e. Abstract, Figure 1 and claim 22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Moshfeghi et al. into the system disclosed by Uchiyama for the purpose of allowing for a more personal internet experience by not only tailoring the information received, based on the behaviors of the user, but by also adding the ability of the user to determine the relevance of his her behaviors and how they affect the presentment of content, thereby offering the user a more powerful and flexible internet content presentment system and method, and this would have been obvious to one of ordinary skill in the art at the time the invention was made.

6. Claims 28 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama, U.S. Patent Application Publication No. 2002/0065802, in view of Masters et al., U.S. Patent No. 5,920,697.

As per claim 28, the rejection of independent claims 1, 9, 17, 25, 27 and 29, is applied equally herein.

As per claims 28 and 33, Uchiyama does not specifically teach the use of a routing table for determination the availability of content provided by respective web sites.

Masters et al. teaches the use of a routing table for determination the availability of content provided by respective web sites (i.e. Figure 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Masters et al. into the teachings of Uchiyama for the purpose of allowing the system of Uchiyama the ability to relay when information pertaining to a site is unavailable, thereby achieving a more effective means of gathering information since time is not wasted on trying to receive content from a provider than cannot provide content for whatever reason, and this would have been obvious to one of ordinary skill in the art at the time the invention was made.



**Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

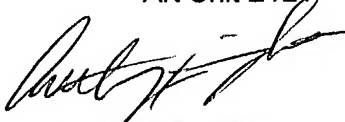
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D Hartman Jr. whose telephone number is 703-308-7001, and after October 12, 2004, (571) 272 - 3684. The examiner can normally be reached on Mon. - Fri., 11:30 am - 8:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179, and starting October 12, 2004, at (571) 272 - 3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDH  
9/14/2004

Ronald D Hartman Jr.  
Examiner  
Art Unit 2121

  
Anthony Knight  
Supervisory Patent Examiner  
Group 3600